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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,993	04/13/2004	Douglas B. Macrae	IS-105 Cont.	5005
75563 7590 07/24/2008				
ROPES & GRAY LLP				
PATENT DOCKETING 39/361				
1211 AVENUE OF THE AMERICAS				
NEW YORK, NY 10036-8704				
EXAMINER				
GRAHAM, PAUL J				
ART UNIT		PAPER NUMBER		
2623				
MAIL DATE		DELIVERY MODE		
07/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,993

Applicant(s)

MACRAE ET AL.

Examiner

PAUL J. GRAHAM

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/18/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION***Response to Arguments***

1. Applicant argues:
2. *In Lett, the data that is stored in not used to update the EPG database for a program listing.*
3. The Examiner respectfully disagrees. Lett teaches that the EPG is produced (and therefore reproduced or updated) by the subscriber terminal from data stored in its memory (see Lett, col. 11, ll. 8-14). The EPG data is stored in memory of the terminal and used to update the EPG (see Lett, col. 13, ll. 5-60, including program listings, col. 13, ll. 23-26).

Youman does not teach update to a program listing.

The Examiner respectfully disagrees. In fact, reading the claims in the broadest sense, Youman does teach update to a program list. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988, F.2d 1181,26 USPQ2d 1057 (Fed. Cir. 1993). Youman does teach that the program list is updated with the use of a channel preference list, only the listings of said channels are viewable (Youman, fig. 8, col. 27, ll. 40-60). With respect to the argument of rejection on claim 4, the detection mechanism of the EPG system for detecting the unscrambled (yet regularly- scrambled) channel does not fade away, it will still detect when the channel is unscrambled, when the Free HBO preview is available it is tunable and the detection mechanism accounts for that with a listing that is viewable without PPV purchase screen and in fact, as listed on the favorite channels list, it is only those that are tunable (see Youman, col. 26, l. 63-col. 27, l.65). The applicants' arguments have been fully considered and are not persuasive. Claims 1-12 stand rejected.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2623

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lett et al. (US 5 592 551)

As to claim 1, Lett discloses a television schedule system configured with an electronic program guide (EPG) database, the system comprising (see Lett, fig. 1 and col. 4, ll. 10-20 for schedule system; col. 5, ll. 40-47 for EPG database):

a receiving location for receiving a plurality of regularly scrambled television channels and a plurality of regularly unscrambled television channels (see Lett, fig. 1 for receiving location 12 and 14, fig. 4B for listing of scrambled/unscrambled channels (e.g., WXIA-14 = unscrambled, HBO-15=scrambled); and a processor (secure micro in Lett, fig. 3) for maintaining the EPG database with program listings for a plurality of the regularly unscrambled television channels (see Lett, col. 6, ll. 18-25), the processor further updating the EPG database for a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels, to a user that is a non-subscriber to the transmitted program (see Lett, col. 14, ll. 55-60, where a free preview (for whatever time period) must be an unscrambled version of a regularly scrambled program and col. 10, ll. 55-60 for processor updating database, see Lett, col. 14, ll. 40-60, the viewer of the potential PPV program is a non-subscriber to the transmitted channel because he is watching a *free* preview, an enticement to get him to subscribe (pay) for that program).

Art Unit: 2623

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Youman et al. (5629733).

As to claim 1, Youman discloses a television schedule system configured with an electronic program guide (EPG) database, the system comprising (see Youman, col. 1, ll. 7-11, col. 7, ll. 51-55 for EPG info and col. 8, ll. 18-21 for database and note title of patent):

a receiving location for receiving a plurality of regularly scrambled television channels and a plurality of regularly unscrambled television channels (see Youman, col. 8, ll. 18-21 for location, fig. 8 for regularly unscrambled channels and fig. 10 for regularly scrambled channels); and a processor (microcontroller in fig. 1) for maintaining the EPG database with program listings for a plurality of the regularly unscrambled television channels (see Youman, col. 8, ll. 18-25; col. 9, ll. 8-17), the processor further updating the EPG database for a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels (see fig. 28, where database is updated for promo channel—HBO channel unscrambled for weekend and EPG shows that information; and see col. 27, ll. 42-54 where processor updates the db when user subscribes to a regularly scrambled channel—there is a message confirming user request, see fig. 9 for promo, which would not be displayed once the user has subscribed to that channel; therefore an update to the db is necessary to update such information as obtained through the EPG an no longer display the subscription message any longer, Youman does teach that the program list is updated with the use of a channel preference list, only the listings of said channels are viewable (Youman, fig. 8, col. 27, ll. 40-60)).

As to claim 2, Youman discloses the system of claim 1, wherein updating the EPG database includes turning on one of the regularly scrambled television channels which is now unscrambled (see Youman col. 8, ll. 21-24), for displaying program listings of the program transmitted on the now unscrambled channel (see Youman, fig. 10 with channels for premium service).

As to claim 3, Youman discloses the system of claim 1, wherein updating the EPG database includes adding the program listing of the program transmitted without scrambling into the database (see Youman, col. 8, ll. 21-24 on updating the listings and fig. 10 showing premium channel schedules).

As to claim 4, Youman discloses the system of claim 1, further comprising a detector coupled to the processor for detecting whether one of the regularly scrambled television channels is now unscrambled (see Youman, fig. 28A, where the message "Free HBO Preview Tonight" is displayed; here the system detected a new channel is going to be available therefore a detection mechanism must be coupled to the processor).

As to claim 5, Youman discloses the system of claim 4, wherein the processor updates the EPG database based on the output of the detector (see Youman, col. 8, ll. 21-24 and col. 27, ll.42-54).

As to claim 6, Youman discloses the system of claim 1, wherein the processor receives data from a service provider indicating the periods during which one of the regularly scrambled television channels will be unscrambled (see Youman, fig. 28 and 28A, where the figs. Tell that HBO will become available "tonight" or "this weekend"; therefore, the database received the info from the service provider noting that HBO would be unscrambled for this time period).

As to claim 7, Youman discloses the system of claim 1 further comprising a display for displaying a portion of the EPG database in a guide format (see Youman, figs. 6, 8, 18, 19, 20, 25 for example displays).

As to claim 8, Youman discloses the system of claim 7, wherein the display further displays a promotional message in the guide for informing a viewer that one of the regularly scrambled television channels is now unscrambled (see Youman, fig. 28A where "Free HBO tonight" is a promotional message of a regularly scrambled channel).

Art Unit: 2623

As to claim 9, Youman discloses the system of claim 8, wherein the promotional message is visually distinguished from the program listings of programs transmitted on one or more of the regularly unscrambled television channels (see Youman, fig. 28 – where the message is in BIG letters and separated from other info on the display).

As to claim 10, Youman discloses the system of claim 8, wherein the portion of the EPG database including a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels is displayed upon user selection of the promotional message (see Youman, fig. 28A where user clicks on the promotional message: "Free HBO Preview Tonight" and figs. 9, 10, and 18 show the listing for scrambled channels).

As to claim 11, Youman discloses the system of claim 1, wherein the processor further adds one of the regularly scrambled television channels into a list of displayed channels (see Youman, figs. 9, 10, 18 show the listings for regularly scrambled channels).

As to claim 12, Youman discloses the system of claim 1, wherein the processor further transmits an order to subscribe the television system with a service provider of one of the regularly scrambled television channels (see Youman, fig. 26 requesting subscription to a movie or special event or family programming; and fig. 9 to order the HBO channel; fig. 10; fig. 23-24a shows the process of subscribing to a channel to watch a movie).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2623

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski et al. (US 5 734 589) in view of Lett et al. (US 5 592 551)

As to claim 1, Kostreski discloses a television schedule system configured with an electronic program guide (EPG) database, the system comprising (see Kostreski, fig. 3 and 5 for schedule system; col. 5, ll. 60-67 for EPG database):

a receiving location for receiving a plurality of regularly scrambled television channels and a plurality of regularly unscrambled television channels (see Kostreski, fig. 3 for receiving location, fig. 5 for listing of scrambled/unscrambled channels (e.g., NBC-4 = unscrambled, Star Wars-12=scrambled); and a processor (microprocessor in Kostreski, fig. 1) for maintaining the EPG database with program listings for a plurality of the regularly unscrambled television channels (see Kostreski, col. 4, ll. 20-44),

Kostreski does not teach an unscrambled program transmitted on a regularly scrambled channel, however, Lett, who discloses an interactive EPG, does teach this.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the schedule system of Kostreski with the EPG of Lett to augment the viewing options of end users to include previewing a PPV event for a period of time (see Lett, col. 14, ll. 55-61).

the processor further updating the EPG database for a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels (see Lett, col. 14, ll. 55-60, where a free preview (for whatever time period) must be an unscrambled version of a regularly scrambled program and col. 10, ll. 55-60 for processor updating database, Lett teaches that the EPG is produced (and therefore reproduced or updated) by the subscriber terminal from data stored in its memory (see Lett, col. 11, ll. 8-14). The EPG data is stored in memory of the terminal and used to update the EPG (see Lett, col. 13, ll. 5-60, including program listings, col. 13, ll. 23-26)).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J. Graham whose telephone number is 571-270-1705. The examiner can normally be reached on Monday-Friday 8:00a-5:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pjg
7/8/2007

/Vivek Srivastava/
Supervisory Patent Examiner, Art Unit 2623